REMARKS/ARGUMENTS

Applicants' prior amendment after final submitted September 29, 2005 inadvertently omitted reference to the status of claims 1-10. Applicants request consideration and entry in lieu thereof the accompanying amendment to the claims including an appropriately revised full listing of the claims, and consideration of the arguments set forth below.

Applicants request notification regarding the entry of the Terminal Disclaimers previously filed on September 29, 2005, which were filed together with the petition for a one month extension of time.

Upon entry of this amendment, Claims 11-20 would remain in this application. Claim 11 would be amended. Claims 1-10 have been cancelled.

The amendment to claim 11 would merely revert the claim to its original content as filed and as taken up for examination in the initial Office Action. Therefore, it raises no new issues requiring further consideration and/or search, and it raises no issues of new matter. It also would place the application in better form for any appeal taken by materially simplifying the issues for appeal. It was not earlier presented as it relates to a new position taken in the final Office Action in response to Applicant's previous amendment.

Turning to the specific objections and rejections:

Claim Rejection under 35 U.S.C. § 112, first paragraph

Claims 11-20 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

While Applicants disagree with this rejection in view of application disclosure as filed, Applicants are deleting and retracting the subject language from claim 11 in the interest of simplifying and advancing prosecution of the above-captioned application.

Claim Rejections for Obviousness-Type Double Patenting

2. Claims 11-20 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-22 and 24-28 of copending application No. 10/655 478 of Akashe.

In response, on September 29, 2005 Applicants filed in the above-captioned matter a Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection Over a Pending "Reference" Application and an authorization to charge Deposit Account No. 06-1135 for any appropriate fees.

Applicants submit that the terminal disclaimer overcomes this nonstatutory double patenting rejection.

3. Claims 11-20 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending application No. 10/655,259 of Akashe.

In response, on September 29, 2005 Applicants filed in the above-captioned matter a Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection Over a Pending "Reference" Application and an authorization to charge Deposit Account No. 06-1135 for any appropriate fees.

Applicants submit that the terminal disclaimer overcomes this nonstatutory double patenting rejection.

Claim Rejection under 35 U.S.C. § 103(a)

4. Claims 11-20 stand rejected under 35 U.S.C. § 103(a) over Goodnight, Jr. et al. (U.S. Patent No. 4,091,120) in view of Cole et al. (U.S. Patent No. 5,725,899).

The final Office Action indicates that that these claims stand rejected for the same reasons set forth in the first Office Action dated October 1, 2004, other than some additional commentary that was provided relative to claim language which would be deleted from claim 1 upon entry of this amendment.

Referencing ¶6 of the Office Action dated October 1, 2004 (pp. 4-5), that Office Action urged, among other things, that Goodnight, Jr. et al. disclose:

... the pH of the [soybean] slurry is adjusted as set forth in the instant claims and the resulting slurry is passed through an ultrafiltration membrane ... (Office Action of 10/1/2004, p. 4).

Applicants point out that Goodnight, Jr. et al. fail to disclose a pH adjustment for 'the resulting slurry ... passed through an ultrafiltration membrane' as set forth in the instant claims.

Instant claim 11 recites that the deflavored soy milk material is prepared by a method which includes, in combination with other steps, the following process steps:

...

(b) solubilizing the soy proteins by adjusting the soy milk composition of (a) to a pH in the range of about 9 to about 12 and releasing the flavoring compound;

(c) passing the pH-adjusted soy milk composition of (b) adjacent an ultrafiltration membrane having a molecular weight cutoff up to about 50,000 Daltons, while maintaining the pH in the range of about 9 to about 12, under suitable ultrafiltration conditions wherein the flavor compounds pass through the membrane, thereby deflavoring the soy milk composition and retaining substantially all of the solubilized soy proteins;

... (*Applicants' emphasis added by underlining*).

As explained in the present specification, solubilizing the soy proteins in a pH range of about 9 to 12 is important because, in general, a pH of 9 is needed to solubilize all of the proteins, while a pH higher than 12 is likely to cause undesirable degradation of the proteins (page 11, lines 16-20).

Importantly, the pH range of about 9 to about 12 also should be maintained during ultrafiltration to allow as much of the flavoring compounds as possible to be removed (page 11, lines 30-32; Example 1). The relied upon prior art completely fail to appreciate, teach or suggest this important feature of the present invention.

Applicants point out that Goodnight, Jr. et al. describe a step (a) extraction process conducted at "less than pH 10," and preferably "pH 7 to pH 9 (col. 2, lines 34-37, 63-64). According to Goodnight, Jr. et al., it is preferred not exceed pH 10.0, *inter alia*, during extraction "in the interest of preserving the nutritional quality of the soy protein' (col. 2, lines 52-55).

It is also noted that Goodnight, Jr. et al. describe a step (b) involving separation of spent flakes or meal from the extract using conventional solid separation unit processes to provide a clarified extract for further processing (col. 3, lines 8-23).

Goodnight, Jr. et al. describe a step (c) in which the clarified extract obtained from Goodnight's solid separation step (b) is then subjected to membrane filtration using a semi-permeable membrane, preferably using an ultrafiltration apparatus, in which the membrane has capability to retain dissolved protein and to pass dissolved carbohydrates (col. 3, lines 34-56).

Importantly, Goodnight, Jr. et al. state that the clarified extract preferably is adjusted to a pH in the range of pH 6.5 to pH 7.5 prior to membrane filtration (col. 3, lines 39-42).

Goodnight, Jr. et al. also suggest that the 6.5 to 7.5 pH range for ultrafiltration "is not essential" (col. 3, lines 41-42). However, that bare passing comment in the Goodnight Jr. et al. reference is never further developed, nor is an enabling disclosure provided in the Goodnight, Jr. et al. reference for use of different pH during ultrafiltration other than one exclusively in the 6.5 to 7.5 range.

For instance, in working Example 1 of Goodnight, Jr. et al., the extract charged to ultrafiltration process had a pH of 7.36 (col. 7, lines 21-23). No ultrafiltration process pH value outside the 6.5 to 7.5 range is illustrated by Goodnight, Jr. et al.

In fact, Goodnight, Jr. et al. would have expressly guided and directed one of ordinary skill away from the present invention and instead towards using a pH of 6.5 to 7.5 during ultrafiltration by their following words:

Membrane filtration in the range of pH 6.5 to pH 7.5 has the benefit of minimizing decomposition or interaction of the protein constituents of the extract during the period of membrane filtration which may require several hours. (col. 3, lines 42-46).

In view of at least the above, Applicants respectfully submit that Goodnight Jr., et al. fail to teach and suggest process step (c) of instant claim 11 reciting ultrafiltration processing with the pH maintained in the range of about 9 to about 12. Moreover, Goodnight Jr., et al. teach and lead away from that possible practice, as discussed above.

It is well-established that the totality of the prior art must be considered, including portions that would lead away from the claimed invention, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness. E.g., *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986)(Applicant's claimed process for sulfonating diphenyl sulfone at a temperature above 127°C was contrary to accepted wisdom because *the prior art as a whole suggested using lower temperatures for optimum results* as evidenced by charring, decomposition, or reduced yields at higher temperatures).

Applicants submit that the relied upon secondary reference to Cole et al. fails to compensate for the above-identified difference or differences existing between the primary reference and the instant claims In fact, Cole et al. fails to teach anything about ultrafiltration, much less pH range values for such processes.

Applicants submit that the above-noted differences between the instant claims and the relied upon prior art are merely exemplary, and Applicants reserve their right to raise additional arguments regarding other differences, as desired or needed.

In view of the above, Applicants respectfully submit that a *prima facie* case of obviousness has not been established against any of the present claims 11-20 based on Goodnight, Jr. et al. and Cole et al. and, accordingly, they request withdrawal of this rejection.

CONCLUSION

In view of the above, it is believed that this application is in condition for allowance, and notice of such is respectfully requested.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

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